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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Barraclough *et al.* Examiner: Ramakrishnaiah, M.
Serial No.: 08/941,975 Group Art Unit: 2614
Filed: October 1, 1997 Docket No.: 8X8S.088US01
Title: Videoconferencing Arrangement Having Multi-Purpose Digital Still Camera

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this communication is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Board of Patent Appeals and Interferences; United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, on Monday, September 25, 2006.

By:

Kelly S. Waltigney

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BOARD OF PATENT APPEALS
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REPLY BRIEF (After Remand of March 16, 2005)

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Sir:

This is a Reply Brief submitted pursuant to 37 C.F.R. § 41.41(a)(1) for the above-referenced patent application. In its Remand, mailed on March 16, 2005, the Board ruled that the Examiner's sole reliance on an English abstract of a Japanese reference was improper (because full translation and citations thereto are generally required), and that Appellant's summary of invention was incomplete. In response to Appellant's Amended Appeal Brief (dated June 7, 2005), the Examiner filed the Answer with its attachment being a largely-complete English translation of the relied-upon Japanese reference.

As indicated herein, Appellant submits that the English translation supports Appellant's positions, and, specifically, the relied-upon Japanese reference does not correspond to Appellant's claimed invention, and Appellant's §1.131 Declaration(s) establish that the Japanese reference is not prior art. The appeal of the instant application should be maintained and the rejections overruled.

No fee should be necessary, but authorization is given to charge/credit Deposit Account No. 50-0996 (8X8S.088US01) for any necessary fee in support of this filing.

I. Status of Claims

Claims 1-5 and 7-14 remain for consideration and are the subject of this appeal. Appellant had previously canceled claim 6 without prejudice to an opportunity of further prosecution in a related application.

II. (New) Grounds for Rejection

The Section 102(a) and 103 rejections are based on a translation of an abstract of *Iwasaki JP 3-229588* (“the *Iwasaki* reference”). Generally, Applicant submits that:

- the *Iwasaki* reference confirms that the asserted reference does not correspond to Appellant’s claimed invention (the Examiner has not attempted to provide “citation [to] and reliance on the underlying scientific document itself” (Remand by Board at p.2); and
- the Inventor Declaration(s) under 37 C.F.R. § 1.131 are effective to “swear behind” the *Iwasaki* reference and therefore remove the rejections entirely.

The above two points are brought out more specifically under the original issues presented for appeal, as follows:

- i. Should (alleged) prior art rejections be maintained when they fail to comply with evidentiary requirements and result in a misrepresentation of the teachings of the asserted Japanese reference (*Iwasaki JP 3-229588*)?
- ii. Has a *prima facie* prior art rejection been established when neither the Office Action nor the asserted art evidences the claimed videocommunicator having a video output port that is capable of communicatively coupling to a communications channel for providing videoconferencing?
- iii. Has a *prima facie* prior art rejection been established when neither the Office Action nor the asserted art evidences the claimed set-top box with related input and output ports and user control input device?
- iv. Has a *prima facie* prior art rejection been established when neither the Office Action nor the asserted art evidences the claimed pan, tilt, zoom functions?
- v. Has a *prima facie* case of obviousness been established when no evidence of motivation for the combination has been identified in support of the obviousness rejection?
- vi. Are the Declarations (with a photocopy of the working prototype board) and the substantial patent application filing, as submitted pursuant to 37 C.F.R. § 1.131, sufficient to “swear behind” the asserted references using the standard set forth in MPEP 715?

VII. Grouping of Claims

The claims do not stand or fall together. The claims should be grouped as follows:

Group A: claim 1; Group B: claims 2-5; Group C: claims 7-11, 13; Group D: claim 12; and Group E: claim 14. These claims are distinguishably separable for the reasons discussed in the Argument.

VIII. Argument

Appellant submits that each of these claim groups is patentably distinguishable. For example, each of the claims outside of Group A includes the patentably distinguishing features of: (1) a video communicator with a DSP unit operating to process compressed video; and/or (2) a video communicator as part of a set-top box; the claims of Group A do not require either aspect. The claims of Group B require only the first of these aspects, the claims of Group C require both aspects; and the claims of Group D require only the second of these aspects. Claim 14 of Group E, unlike any of the other claims, requires use of a videocommunicator for controllably altering a display, including at least one of pan, tilt and zoom functions, of the video input signals without controlling the digital still camera.

The above claim groupings overlap with the following issues. Issues i, ii and vi pertain to each of the claims 1-14. Issue iii pertains to each of the claims (7-13) in Groups C and D. Issue iv pertains to claim 14 of Group E. Issue v pertains to each of the claims (2-11, 13) in Groups B and C.

i. The rejections based on the Japanese reference fail to comply with evidentiary requirements and are based on a misrepresentation of the teachings of the asserted reference (*Iwasaki JP 3-229588*).

The Answer confirms that the appealed claims were improperly rejected under Section 102 and Section 103 because the rejections were based on a misinterpretation (and a partial reading) of the *Iwasaki JP 3-229588* reference (“the *Iwasaki* reference”).¹ In the Remand Decision of March 16, 2005, the Board held that “a translation of *Iwasaki* is needed for our review of the rejections” and that “the examiner should base his rejections on the translation, citing thereto.” Remand Decision at p. 3. Accordingly, while Appellant understood the Answer was to provide citations to the Japanese reference in support of the rejections, Applicant fails to recognize how the Answer complies with this requirement in any respect.

In the Answer, Applicant can find no specific reference to any aspect of the *Iwasaki* reference apart from the original citations to its drawings and Abstract, and general mention of pages 4-10. For example, each of the claims requires a videocommunicator having a video output port that is capable of communicatively coupling to a communications channel for providing videoconferencing. Apparently due to translation problems with the abstract and figures of the Japanese reference, the Examiner alleges generally that these limitations of the claimed invention are satisfied by functional item “4” of the Japanese reference. The Examiner’s rejection provided no other information.

Functional item “4” of the Japanese reference is useful to illustrate the substantive problem with the examiner’s failure to provide citations to the translated *Iwasaki* reference. At page 7 of the translated *Iwasaki* reference, item “4” is said to be “an image processing part 4” that is adapted for receiving, via switch 17, a video signal from a “built-in video camera 7” or a VTR 16. Contrary to the position of the Examiner, this “item 4” does not correspond to Appellant’s claimed “output port capable of communicatively coupling to a communications channel for providing videoconferencing” (e.g., claim 1), and the record is devoid of any

¹ In its Appeal Brief, Applicant submitted that the Examiner did not comply with the patent statute and other federally-mandated regulations previously presented by the Applicant and should not have attempted to substantiate the prior art rejections on a partial reading of the *Iwasaki* abstract. In the Remand (Decision by the Board of March 16, 2005), the Board ruled that the appeal was not ready for a decision on the merits with citation, in part, to: *Ex parte Jones*, 62 USPQ2D 1206, 1208 (Bd.Pat.App.& Int. 2001 (“Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art”).

interpretation that would be useful in understanding how the translated *Iwasaki* reference is being relied upon for this and other aspects of the claimed invention. Later in the Answer, the Examiner also alleges that “item 4” is Appellant’s claimed “input port” as well as the claimed “second input port” (see Answer at p. 5, line 10; p. 7, lines 11 and 19-22).²

Based on a review of the translated *Iwasaki* reference, other examples of noncorrespondence include: “digital still camera” of claim 1 (as supported with specified digital-image ITU-based formats (*e.g.*, p. 6 of Specification)) as opposed to the “built-in video camera 7” of the *Iwasaki* reference with no explanation of implementation or formatting; and in the context of a set-top box (claims 7 et seq. or otherwise), the *Iwasaki* reference does not teach use of a set-top box or a videocommunicator having both a video input port and a video output port for videoconferencing.

For these reasons and those discussed below, Applicant submits that the Examiner did not comply with the requirements set forth in the Remand to provide a record of how the *Iwasaki* reference would be relied upon to establish any support for the argument that this reference corresponds to the claimed invention. In view thereof, Appellant requests that the Section 102 and Section 103 rejections be reversed.

ii. A *prima facie* prior art rejection has not been established because neither the Office Action nor the asserted art evidences the claimed videocommunicator has a video output port that is capable of communicatively coupling to a communications channel for providing videoconferencing.

The Examiner has failed to provide a rational in support of the position that the picture processing portion 4 of the *Iwasaki* reference is (or provides) any kind of output port capable of communicatively coupling to a communications channel for providing videoconferencing. The *Iwasaki* teachings regarding item “4” do not include any aspect of functional portion “4” having any output port, no less an output port capable of communicatively coupling to a communications channel for providing videoconferencing. Item 4 is merely a generalized

² At page 10 of the Answer, the Examiner makes an attempt to explain how “item 4” has been interpreted and asserted; Appellant, however, fails to recognize any further clarity to this confusion.

functional section of a processing scheme and it bears no resemblance to the invention claimed whatsoever.

As a first example, the Examiner relied upon item “4” as allegedly corresponding to both the Appellant’s claimed “input port” and Appellant’s claimed “output port capable of communicatively coupling to a communications channel for providing videoconferencing” (e.g., claim 1). Contrary to this general position of the Examiner, at page 7 of the translated *Iwasaki* reference, item “4” is said to be “a image processing part 4” that is adapted for receiving, via switch 17, a video signal from a “built-in video camera 7” or a VTR 16. This “item 4” does not correspond to Appellant’s claimed “output port capable of communicatively coupling to a communications channel for providing videoconferencing” (e.g., claim 1). The *Iwasaki* reference does not teach that its image processing part 4 has any output port whatsoever or that is capable of communicatively coupling to a communications channel for providing videoconferencing. Rather, as discussed near the bottom of page 4 of the *Iwasaki* translation, image processing part 4 is one of several functional portions that are ultimately used to convert the form of an image signal from the video camera 7 (or the VTR 16) to a “encoding part 8” to a “system control part 2” and then on to “a digital line 20”. Based on this discussion of functional “portions” versus “digital line 20” and with either the abstract or the entirety of the *Iwasaki* reference upon which to rely, Appellant fails to recognize how the skilled artisan (or the Examiner) could interpret the functional portion corresponding to “image processing part 4” as having a tangible output port.

Similarly, each of claims 7-13 requires a set-top box arrangement and, apparently also due to translation problems, the Examiner has erroneously alleged that items 1-5 and 8-15 of the *Iwasaki* reference constitute a certain type of set-top box. No other information was provided, for example, teaching from the *Iwasaki* reference that indicates upon what these functional portions reside on, or whether these functional portions are even enclosed with each other inside any type of housing. Moreover, the Examiner has maintained this interpretation with disregard of numerous input and output ports required as being part of the claimed set-top box. For instance, in connection with the rejection of claim 7, the Examiner refers to the first and second input ports of the set-top box as functional portions “4,2” and immediately thereafter refers to functional portions “4” as the claimed output port of the set-top box. In reality, neither item 4

nor item 2 is an input or an output port. As discussed above, denoters 4 and 2 are used to refer to functional aspects of a processing flow.

Because limitations relating to this aspect of the claimed invention are found in each of the rejected independent claims and the asserted reference (or combination of references as the rejection applies) does not include a corresponding element for each claimed limitation, Appellant submits that each of the 102 and 103 rejections should be removed.

iii. A *prima facie* prior art rejection has not been established because neither the Office Action nor the asserted art evidences the claimed set-top box with related input and output ports and user control input device.

Also as discussed above and incorporated herein, the Examiner has failed to provide a rational in support of the position that the cited functional portions 1-5 and 8-15 of the *Iwasaki* reference constitute a set-top box, or constitute any of the aspects claimed as being part of the set-top box.

Throughout the supporting rationale behind the rejections, the Examiner has confused the above-discussed functional portions with input and output ports. In addition to the above (incorporated) examples, another specific example of this deficiency is found in connection with the output port of the set-top box being coupled to pass image signals to the display, as set forth in each of claims 7-13. At page 2 of the Final Office Action dated June 19, 2000, the Examiner has alleged generally that “the video output port” can communicatively couple to the videocommunicator while, in the same sentence, arguing that the first input port 4 is an output port 4 which is also the output port for the display.

Further, each of claims 7-13 includes limitations relating to user control inputs. For example, these claims require a telephone circuit or control unit coupled to the first telephone port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box. At page 2 of the Final Office Action, the Examiner defines item 4 as a control unit adapted to receive user inputs for controlling the set-top box. The Examiner previously defined item 4 as an input port and also as an output port.

Because limitations relating to these aspects of the claimed invention are found in each of rejected claims 7-13 and the asserted reference (or combination of references as the rejection

applies) does not include a corresponding element for each claimed limitation, Appellant submits that each of the 102 and 103 rejections should be removed.

iv. Has a *prima facie* prior art rejection been established when neither the Office Action nor the asserted art evidences the claimed pan, tilt, zoom functions?

Neither the abstract nor the completely translated version of the *Iwasaki* reference (modified via the Section 103 rejection or not) can be used to maintain that the asserted art teaches the electronic pan-tilt-zoom operation defined by claim 14. Claim 14 states in pertinent part: “A method of videoconferencing comprising the steps of: *** using the videocommunicator for controllably altering a display, including at least one of pan, tilt and zoom functions, of the video input signals without controlling the digital still camera.” The Office Action erroneously alleges at the bottom of page 4 of the Final Office Action that “picture thinning” is the same as claimed pan, tilt and zoom functions; no basis is provided for this conclusion. In contrast, the completely translated version of the *Iwasaki* reference teaches that the “picture thinning” function is for duplicating (or “reproducing”) pictures for display purposes, as is discussed at length in connection with item 3 (*e.g.*, at pages 5 and 11) which the *Iwasaki* reference call “the decoding part 3.”

Because an element relating to this aspect of claim 14 is not found in the asserted reference (or combination of references as the rejection applies), Appellant submits that the 103 rejection of claim 14 should be removed.

v. A *prima facie* case of obviousness has not been established because no evidence of motivation for the combination has been identified in support of the obviousness rejection.

In connection with the rejection of claims 2-11 and 13, the Examiner has not presented any evidence for the requisite motivation for establishing the asserted combination. The Examiner’s asserted motivation is only a statement that it is desirable to enable the user to select the most desirable compression algorithm to achieve the desired results. Appellant has not been provided with any citation to the prior art that would correspond to this desire, and neither asserted reference appears even remotely related to this notion of selecting a desirable compression algorithm. Moreover, “the desired results” are not well defined. The *Iwasaki* abstract does not teach the ability for a user to input any data for this purpose, and the completely

translated version also appears to fail in this regard. Further, the modifying reference (5,106,107) is not cited for this teaching. Accordingly, no evidence has been presented that the skilled artisan would be so motivated to modify the *Iwasaki* reference in this alleged manner.

Relevant case law does not permit a Section 103 rejection to be maintained wherein there is no suggestion to make such modification. Section 103 dictates that the motivation to make the asserted modification must be present “at the time the invention was made.” In the present instance, any asserted motivation in the Office Action does not refer to motivation present in the prior art at the time the invention was made, or at any time. Applicant respectfully submits that this rejection must be removed because the combination of references lacks motivation and, therefore, does not present a *prima facie* case of obviousness. Addressing the “rigorous ... requirement for a showing of the teaching or motivation to combine prior art references,” the Court of Appeals for the Federal Circuit recently stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, [citations omitted], although “the suggestion more often comes from the teachings of the pertinent references,” *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. *See, e.g., C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” [citation omitted]

In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). As applied here, no relevant support has been provided for making the asserted modification. Therefore, Applicant submits that the asserted combination is not motivated and cannot be made.

vi. The Declarations (with a photocopy of the working prototype board) and the substantial patent application filing four months after the publication comply with 37 C.F.R. § 1.131 and are therefore sufficient to “swear behind” the asserted references using the standard set forth in MPEP 715.

Notwithstanding the above distinctions, Appellant has provided adequate evidence in character and weight, so as to establish reduction to practice prior to the publication date (October 11, 1991) of the reference, and/or conception of the invention prior to the *Iwasaki* publication date, coupled with due diligence from prior to said date to the filing of the

application. MPEP 715 clearly sets forth the requirements for meeting the 1.131 submission and “lack of nexus” does not appear to be discussed.

The evidence of record includes two Declarations by one of the inventors and managers of a team of engineers working on the company-wide project, which project was comprehensively described over a substantial period of time to outside patent counsel for the purpose of preparing the parent patent application (now U.S. Patent No. 5,379,351) to which the instant application claims priority under 35 U.S.C. 120. The second of these Declarations (executed July 19, 2000) clearly establishes the relationship between the claimed invention of the instant application (Serial No. 941,975), the parent patent application (now U.S. Patent No. 5,379,351), and the photocopy of the actual prototype board which was attached to each of the Declarations. This photocopy of the actual prototype board was designed with the IC parts implemented as described in the second of these Declarations (executed July 19, 2000) and as described in the parent application four months after the *Iwasaki* publication date.

Appellant contests the three conclusory statements behind the Examiner’s rejection: a) there is no nexus between the drawings in U.S. Patent No. 5,379,351 and the drawings attached to the second of the Declarations (which is the same as that attached to the first of the Declarations); b) there is “no connection” between the drawings in U.S. Patent No. 5,379,351 and the drawings in the instant specification; and c) the drawings are generic and typical on any computer board circuit. The rationale is erroneous and unsupportable on several counts.

First, a nexus between the drawings in U.S. Patent No. 5,379,351 and the drawings attached to the second of the Declarations has been provided through each of the paragraphs numbered 1-6 of the second of the Declarations.

Second, a “connection” between the drawings in U.S. Patent No. 5,379,351 and the drawings in the instant specification has been provided at length through the “Amendment and Response” filed on April 21, 1999. This “connection” includes a claim chart directly aligning claim 1 of the instant application with the specification and drawings of U.S. Patent No. 5,379,351. Further, a Supplemental (1.63) Declaration was submitted with the Office Action Response of March 10, 2000, with this Supplemental (1.63) Declaration claiming priority under 35 U.S.C. 120 to U.S. Patent No. 5,379,351.

Third, the Examiner's argument that the drawings are generic and typical on any computer board circuit is wholly unsupported, conclusory, and erroneous. Should this position be maintained, Appellant requests evidence in support thereof.

Appellant submits that attempting to access archived computer data corresponding to the out-sourced build out of the custom chips shown on the prototype board and/or the out-sourced build out of the custom multi-layered printed circuit board, would constitute an undue burden and would result in merely another Declaration that interprets the computer data, which would also be subject to the same type of attack received in connection with the conclusory "lack of nexus" rejections presented for each of the submitted Office Actions.

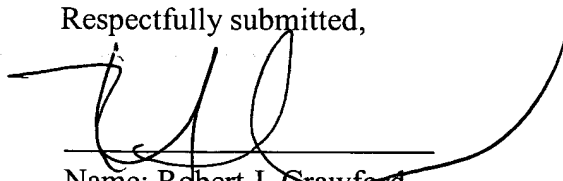
In view of the above, Appellant submits the Declarations submitted pursuant to Section 1.131 adequately demonstrate reduction to practice prior to the *Iwasaki* publication date (October 11, 1991), and/or conception of the invention prior to the *Iwasaki* publication date, coupled with due diligence from prior to said date to the filing of the application, in a manner consistent with the guidelines of MPEP 715. As such, Appellant submits the *Iwasaki* reference is not prior art and that each of the rejections should be removed.

IX. Conclusion

Appellants respectfully request reversal of the rejection as applied to the appealed claims and allowance of the application.

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Enclosed: Appendix of appealed claims

APPENDIX OF APPEALED CLAIMS 1-5, 7-14 (08/941,975)

1. A method of videoconferencing comprising the steps of :
providing a videocommunicator having a video signal input port, a video signal encoding circuit and a video signal output port; and
using a digital still camera to generate video input signals to the video input port of the videocommunicator, the video output port of the videocommunicator capable of communicatively coupling to a communications channel for providing videoconferencing.
2. A method, according to claim 1, further including the step of using the videocommunicator to transmit video signals over the communication channel by processing the video signals using a video-signal processing circuit having a DSP circuit for compression of video data and having a general purpose processor circuit.
3. A method, according to claim 2, further including using a digital still camera to provide video signals representing a live target area along with a split screen representing a stored stilled image.
4. A method, according to claim 3, further including using another output port of the videocommunicator to provide video images for a display.
5. A method, according to claim 4, further including using the other output port to output video data representing images received from the digital still camera along with split screen representation of video images received over the communications channel.
7. An arrangement for use in a videoconferencing system, comprising:
a set-top box having a first video input port and a video output port, and first and second telephone ports, the set-top box configured and arranged to output video signals via the video output port, output local video data signals via the second telephone port, and input remote video data signals via the second telephone port, responsive to control signals at the first telephone port, the set-top box further including a video-signal processing circuit having a programmable

DSP circuit adapted to compress video data and having a programmable general purpose processor circuit;

a camera coupled to the first video input port, and configured and arranged to output video signals representative of stored images of scenes captured by the camera;

a telephone circuit coupled to the first telephone port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box; and

a monitor coupled to the video output port to receive the video signals and display images represented by the video signals.

8. The arrangement of claim 7, further comprising:

the set-top box having a second video input port;

a video camera coupled to the second video input port;

the monitor having a screen viewing area and the set-top box being responsive to control signals to split the screen to simultaneously display a stored image and images represented by the local video data signals.

9. The arrangement of claim 7, further comprising:

the set-top box having a second video input port;

a video camera coupled to the second video input port;

the monitor having a screen viewing area and the set-top box being responsive to control signals to split the screen to simultaneously display a stored image and images represented by the remote video data signals.

10. The arrangement of claim 7, further comprising:

the set-top box having a second video input port;

a video camera coupled to the second video input port;

the monitor having a screen viewing area and the set-top box being responsive to control signals to split the screen to simultaneously display a stored image and images represented by the local video data signals and the remote video data signals.

11. The arrangement of claim 7, further comprising:
 - the set-top box having a second video input port;
 - a video camera coupled to the second video input port;
 - the monitor having a screen viewing area and the set-top box being responsive to control signals to split the screen to simultaneously display a plurality of stored images and images represented by the local video data signals and the remote video data signals.
12. A video image viewing arrangement, comprising:
 - a set-top box having first and second input ports, an output port, and the set-top box configured and arranged to output display signals via the output port responsive to control signals at the second input port;
 - an external video camera coupled to the first input port of the set-top box, configured and arranged to output video signals;
 - a control unit coupled to the second input port and configured and arranged to receive user control inputs and, responsive thereto, provide control signals to the set-top box; and
 - a display coupled to the output port of the set-top box to receive the display signals.
13. A video image viewing arrangement of claim 12, wherein the control unit further includes a video-signal processing circuit having a programmable DSP circuit adapted to compress video data and having a programmable general purpose processor circuit and wherein the display has a screen viewing area and the set-top box is responsive to control signals to split the screen to simultaneously display video information from the internal video camera and video information from the external video camera.

14. A method of videoconferencing comprising the steps of :
- providing a videocommunicator having a video signal input port, a video signal output port, and a video signal encoding circuit with a programmable DSP circuit adapted to compress video data and with a programmable general purpose processor circuit;
 - using a digital still camera to generate video input signals to the video input port of the videocommunicator, the video output port of the videocommunicator capable of communicatively coupling to a communications channel for providing videoconferencing; and
 - using the videocommunicator for controllably altering a display, including at least one of pan, tilt and zoom functions, of the video input signals without controlling the digital still camera.